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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/672,060	09/29/2003	Stephen Fitzgerald	CE-COMP-04.US	4727

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EXAMINER	
GRAHAM, MARK S	
ART UNIT	**PAPER NUMBER**
3711	

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/672,060	FITZGERALD ET AL.	
	Examiner	Art Unit	
	Mark S. Graham	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-30 and 33-71* is/are pending in the application.

4a) Of the above claim(s) *See Continuation Sheet* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-39, 42/(37-39), 43/42/(37-39), 44/42/(37-39), 45/42/(37-39)* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *14-30 and 33-71* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 14-30, 33-36, 40, 41, 42/(36,50), 43/42/(36,40), 44/42/(36,40), 45/42/(36,40), 46-71.

Applicant's election with traverse of the Fig. 6 embodiment in the reply filed on 8/31/05 is again acknowledged. The Fig. 6 embodiment as originally disclosed and shown comprised a single wall bat wherein the barrel portion by virtue of a localized area of fiber type and/or angle change 20 resulted in an increased radial stiffness generally in the sweet spot area 19 located in proximity to the middle area of the barrel length. This is the Fig. 6 embodiment which was elected. It is further stated in the original specification after the description of Fig. 6, that variations, not shown, on this embodiment could include double or multi-wall bats or increased thickness in the barrel portion. Applicant has now submitted additional drawing figures directed towards these embodiments.

Newly submitted claims 53-71 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 53-71 are directed towards an embodiment as depicted in Figs. 6.1 and 6.3 comprising a bat with a thickened central barrel portion.

Since applicant has received an action on the merits for the originally presented and elected invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 53-71 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The amendment filed 6/7/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment

shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

Newly added Figs. 6.1-6.3 contain new matter. Regarding the Figs. Of 6.1 and 6.3 there is no original disclosure of a thickened portion shaped as shown in the drawings. In Fig. 6.2 there is not original disclosure of a tapered inner wall at the junction of the barrel and the bat taper.

The new disclosure with regard to Fig. 6 in paragraph 62 lacks basis in the original disclosure. The thickness specifically discussed in the original disclosure only pertains to the embodiments having a stiffener 18 or a variation of the Fig. 6 embodiment. The Fig. 6 embodiment does not offer this feature but instead includes a section 20 of the bat which adjusts the stiffness by means of fiber type or angle change. Applicant's comments regarding this passage have been noted but no support has been offered for showing that the original disclosure intended to include the Fig. 6 embodiment with the limitations discussed with reference to Figs. 4, 5, 7, and 8.

Also in paragraph 62 the more narrowly focused ranges of the stiffener wall thickness, and the inclusion that the barrel wall thickness is also in these ranges represents subject matter with no support in the original disclosure.

In response to applicant's comments, *Wertheim* is not seen to control the instant situation. In *Wertheim,* the applicant had indicated a preference for more focused ranges by specifically disclosing the 36% and 50% values. Here there is no such indication of a prefererence for more focused ranges. With respect to changing numerical range limitations, the analysis must take into account which ranges one

skilled in the art would consider inherently supported by the discussion in the original disclosure (MPEP 2163.05). Here there is no inherent support for the newly introduced range. Without such support applicant has simply selected a range at will within the originally disclosed broad range and shown no particular support for that range being of interest. Moreover, there is not support at all for these thicknesses in the barrel wall as applicant has amended the application to indicate.

The newly added limitations to paragraph 53 represent new matter. There is not support for forming the thickened portion such that no boundary is present between layers.

The newly added limitations to paragraph 64 represent new matter. There is not support for using "layout density" to modify the barrel wall characteristics. No definition of this term is even offered.

Applicant is required to cancel the new matter in the reply to this Office Action.

It is noted that paragraph 62 referenced above was inadvertently referred to as paragraph 61 in the previous office action and that applicant understood that it was paragraph 62 which was being discussed.

Claim 45 is objected to because a block of text is missing. For purposes of this action it has been assumed that claim 45 should read as it did in the previous response.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

> applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 38 is rejected under 35 U.S.C. 102(e) as being anticipated by Vacek. Vacek's insert 112 provided in the center of the barrel contains layers of fibers and thus this portion of the bat barrel has a greater percentage of fibers than do the portions of the barrel at either end of the insert. Inherently this provides the bat with greater radial stiffness at the location of the insert and Vacek specifically points out in paragraph 45 that the insert is to be stiffer than the tubular hitting surface and that it enhances the hitting zone of the bat by increasing the trampoline effect. This is considered an increased or broadened sweet spot. This increased stiffness of the bat at the location of the insert relative to the portions of the bat barrel not covered on the inside by the insert is a change along the barrel length as in the present invention. As can clearly be seen in Fig. 2 of Vacek the insert does not extend the full length of the barrel and thus the properties of the barrel are varied in the same fashion as claimed.

In further response to applicant's comments, it is noted that there is no Fig. 2a in Vacek and thus no showing of a full length insert as asserted.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vacek. Vacek teaches providing greater stiffness to the bat in the area of the

insert. Vacek specifically teaches using a greater percentage of fibers in this area at paragraph 47. However, Vacek also notes that different materials may be used in the insert (paragraph 46) and that the fiber angle may be varied (paragraph 47). Varying the angle of fibers to be greater with regard to the longitudinal axis inherently provides greater radial stiffness and using a stiffer fiber type accomplishes the same result. It would have been obvious to one of ordinary skill in the art to have used either of these known means to provide the extra stiffness in the insert portion desired by Vacek. As the examiner has noted previously different fibers comprise different stiffnesses. Such is now admitted prior art.

In response to applicant's first argument concerning claims 37 and 39, the examiner did not reference paragraph 47 other than as noted above. However, it is true that the area of the bat barrel containing the insert has a greater percentage of fibers than the areas of the barrel on either side of the insert. The remainder of applicant's argument, as was the argument regarding claim 38, is based on the premise that the examiner is asserting a change of fiber amount, type, or angle within the insert itself. However, this has never been the premise of the rejection. As clearly stated in the previous office action "Vacek's insert 112 provided in the center of the barrel contains layers of fibers and thus this portion of the bat barrel has a greater percentage of fibers than do the portions of the barrel at either end of the insert," (emphasis added).

This logic applies equally with regard to using a different fiber type or different fiber angle in the insert of Vacek to increase the stiffness in this portion of the bat barrel.

Claims 42/(37, 38, 39), 43/42/(37, 38, 39), 44/42/(37, 38, 39), and 45/42/(37, 38, 39) are rejected under 35 U.S.C. 103(a) as being unpatentable over Vacek in view of Fritzke. Vacek discloses the claimed device with the exception of the shorter length of the midsection. Fritzke however discloses that such inserts may be shorter and located at the point of the sweet spot of the bat. While an exact length is not disclosed it is clear from Fritzke's drawings that his insert provides the greatest radial stiffness at the sweet spot just as does applicants insert. Absent a showing of unexpected results the exact length of the mid-section would obviously have been up to the ordinarily skilled artisan depending on the particular bat characteristics desired by the batter in the bat.

It is noted that applicant has not specifically addressed this rejection. Regarding applicant's comments as to Vacek and Fritzke taken together though, in both cases the aim of using an insert is to stiffen the impact portion of the bat, (note paragraph 45 of Vacek and paragraph 75 of Fritzke. In both cases a composite insert is utilized. One of ordinary skill in the art considering the art as a whole would obviously conclude that because it was known to use composite inserts to stiffen composite bats as taught by Vacek the use of other composite inserts known in the bat art to stiffen hollow bats as disclosed by Fritzke would also be useful to stiffen hollow composite bats.

Applicant's arguments with respect to claims 37-39 and the claims dependent thereon have been considered but are moot in view of the new ground(s) of rejection and the reasons expressed above.

Applicant's declaration with regard to the Fritzke reference has been considered but is not relevant to the claims and rejections currently at hand. Moreover, the

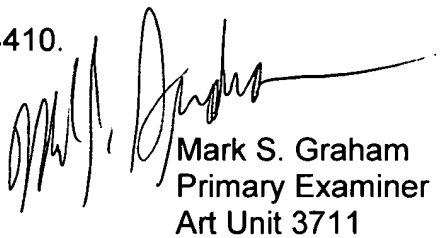
declaration would appear to support the statements the examiner has made with regard to Fritzke in the past.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 571-272-4410.

MSG
6/29/06



Mark S. Graham
Primary Examiner
Art Unit 3711